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Kenyon & Kenyon ONE BROADWAY NEW YORK, NY 10004			CHAMPAGNE, DONALD	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09298763

Filing Date: 23 April 1999

Appellant(s): R. Wood et al.

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Shawn W. O'Dowd, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 April 2005 appealing from the Office action mailed 22 January 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Jovicic et al, US005855007A, 29 December 1998.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 22 January 2004.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 14 October 2003 have been fully considered but they are moot in view of the new basis for rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the other claims, does not reasonably provide enablement for claim 22. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. There is a logical conflict between claim 22 and its parent claim 20. Claim 20 is limited to "without pre-registration of the user", while claim 20 is limited to "a cookie that stores a user ID". "Registration" (or pre-registration) is the process of recording automatically (Merriam-Webster's Online Dictionary), which is what a cookie does. Hence the limitation to a cookie in claim 22 contradicts the limitation to no registration in claim 20.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 1, 5-13, 16-22, 24, 25, 32-35 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jovicic et al.
7. Jovicic et al. teaches (independent claims 1, 17, 19, 20, 32 and 38) a computer-implemented method and system for interactively and electronically distributing and redeeming rewards, the method comprising: displaying a graphic of an electronic coupon, which reads on an advertising image, a reward indicator, and a promotional incentive for purchase transaction, on a computer screen of a local computer, wherein the local computer is coupled to a computer network (col. 4 lines 28-29), and enabling a user to select the image (col. 4 lines 19-20); at a central location coupled to the computer network, seamlessly determining the identity of the user (col. 2 lines 49-51) when said image is selected, and at the central location, automatically allocating a reward associated with the coupon/advertising image when said image is selected, wherein said allocating step includes storing a reward identifier associated with the identity of the user in a database, said reward indicator identifying the coupon, which reads on a promotional incentive.
8. Jovicic et al. also teaches: (claim 20) without pre-registration of a (new) user, where pre-registration is interpreted as registration before the present online session; (claim 32) the user storing and later redeeming coupons (col. 3 lines 11-15), which reads on the user computer enabling the user to select a reward for redemption from the list of rewards previously collected by the user and that are available for redemption;
9. Jovicic et al. does not explicitly teach optionally directing the local computer to a webpage associated with the image. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the user is inherently able to redirect the local

computer to a website of the subject coupon product. Alternatively, because it is a convenient and obvious means for a user to obtain more information on a product for which a coupon is offered, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add optionally directing the local computer to a webpage associated with the image to the teachings of Jovicic et al.

10. Jovicic et al. does not explicitly teach that the purpose of the method and system is increasing the click-through rate for advertisements/to attract traffic to a promoter computer. However, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the purpose of all advertising is product promotion, of which targeted promotion distribution is an important element. Success is measured by the number of coupons that are selected and used, which reads on increasing the click-through rate for electronic coupons/advertisements or attracting traffic to the promoter computer.
11. Jovicic et al. also teaches at the citations given above claims 5-6, 25 and 33-36. The reference also teaches claims 7, 22, 24 and 35 (col. 3 line 27); claims 8-11 and 18 (col. 3 line 13 and col. 6 line 54); claim 12 (col. 6 line 51); claims 16 and 33 (col. 2 line 44); and claims 21 and 34 (col. 7 lines 12-14). The reference also teaches claim 13 inherently as the home page of the Internet Coupon Server (col. 6 lines 5-6).
12. Claims 2-4, 14-15, 23, 26-31, 36, 37 and 39 are rejected under 35 USC 103(a) as obvious over Jovicic et al.
13. Jovicic et al. does not teach (claims 2-4, 23 and 36) storing the user ID number in a cookie/local computer datafile. Because cookies were well-known user conveniences, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add storing the user ID number in a cookie/local computer datafile to the reference invention.
14. Jovicic et al. does not teach (claims 26-31) the user device limitations of these claims (ATM, PDA, etc.). However, the user does teach the genus *general-purpose digital computer* and a PC (col. 5 lines 26 and 41-42). Because the claimed devices were well known and convenient user computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these user computers to the reference invention.

15. Jovicic et al. does not teach (claims 14-15) ID input by magnetic stripe or smart card. Because this is an inherent and convenient means for input with some of the obvious claimed user computers (e.g. ATM), it would have been inherent, or alternatively obvious to one of ordinary skill in the art, at the time of the invention, to input the ID by magnetic stripe or smart card.
16. Jovicic et al. does not teach (claims 37 and 39) means to transfer a reward to another registered user. Because this would be an attractive user feature easily implemented with the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add means to transfer a coupon reward to another registered user to the teachings of Jovicic et al.

(10) Response to Argument

Rejection of claim 22 under 35 USC 112, First Para.

This rejection has been withdrawn.

Rejection of claims 1-39 under 35 U.S.C. 102(e)/103(a)

In pp. 11-14 of the brief, appellant compares alleged properties of the instant and reference inventions without referring to the claims. This does not comply with 37 CFR 41.37(vii), which requires that the arguments express the contentions of appellant with respect to each ground of rejection. It is the claims that have been rejected, not the disclosure.

Indeed, appellant alleges (p. 12 third para.) "... there are many differences between the claims of the present invention and the Jovicic patent, as discussed below." Yet there is no reference to the claims or to the rejection in pp. 11-14 of the brief.

Appellant does contend (first full para. on p. 15) with respect to claim 32 that the reference does not teach "a central computer comprising a central database storing a list of rewards that have been previously collected by the user and that are available for redemption". Appellant contends that the rejection cited col. 3, lines 11-15 as the source of the teaching in Jovicic et al., but that is not what the rejection says. The rejection (para. 8) specifically addresses only one limitation of claim 32, the third limitation beginning "a user computer coupled to the network".

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Appellant is referring to the second limitation of claim 32, for which the teaching is as follows: Jovicic et al. teaches *Internet Coupon Server 124* (col. 6 lines 5-6 and Fig. 1), which reads on a central computer, comprising a central database storing a list of rewards (*Coupon Database 130*, col. 6 line 13) that have been previously selected by the user (col. 2 lines 49-51), which the examiner interprets as previously collected by the user, and that are available for redemption (again col. 2 lines 49-51).

It is reasonable to expect that an applicant/appellant will read a reference, or at least look at the figures. The teaching is strongly suggested by Fig. 1 even without the supporting text.

Appellant also contends (second full para. on p. 15) with respect to claim 7 that the reference does not teach "the allowing access steps of claim 7". The rejection cites as a teaching source col. 3 line 27, but that is incomplete. The complete teaching is at col. 7 line 54-64, where the user is given access to *browsing memory 128*, which reads on both a database (col. 7 line 64) and a list of rewards (coupons).

Appellant does not further discuss the grounds of rejection in the remaining pages 15 and 16. Appellant does argue (p. 15, bottom bullet), without reference to a claim, that "Jovicic does not have a 'reward indicator'". That is a limitation of claim 1, and appellant's contention is not correct. Jovicic et al. does teach displaying a graphic of an electronic coupon, which reads on a reward indicator (para. 7 of the rejection above).

Appellant also argues (bullet on p. 16), again without reference to a claim, that "Jovicic does not teach directing a local computer to a webpage associated with a coupon". That teaching is regarded as inherent, as is explained by para. 9 of the above rejection.

Appellant makes no attempt to consider, much less traverse, this rejection argument.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622



Conferees:

Jeffrey D. Carlson



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5 July 2005